

Practitioner's Docket No. OMG/129/US

REMARKS

A Notice of Allowance and Fee(s) Due for the present application was mailed December 8, 2003. The Issue Fee has not been paid. Applicant is aware that amendments after allowance are "a matter of grace and not of right". MPEP §714.15. However, the foregoing amendments to the claims "are needed for proper disclosure or protection of the invention" and require "no substantial amount of additional work on the part of the Office". MPEP §714.16.

Applicant respectfully requests that allowed claims 1-5, 10, 12-22, 34-42, 44, 68-93, 99, and 101-104 be cancelled. In addition, Applicant respectfully requests entry of presently amended allowed claims 6, 8, and 11. As amended allowed claims 6, 8, and 11 include all of the limitations of any allowed base claim and allowed intervening claims. Upon entry of the foregoing amendment allowed claims 6, 7, 8, 11, 23-33, 45-67, 94-97, 100, 106-110, 113, and 119 will remain in the present application.

Basis For Entry of Amendment After Allowance

37 C.F.R. §1.312 governs amendments after allowance and recites:

"(a) No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment pursuant to this paragraph filed before the payment of the issue fee may be entered on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the case from issue.

Applicant encloses with this Amendment After Allowance of Claims the fee set forth in 37 C.F.R. §1.17(i) of \$130.00, and a showing of good and sufficient reasons why the amendment is necessary and was not earlier presented. 37 C.F.R. §1.312(b). Applicant herein states the reason (1) why the amendment is needed, (2) why the proposed amended or new claims require no additional search or examination, (3) why the claims are patentable, and (4) why they were not earlier presented. MPEP §714.16.

Reason for Amendment

Applicant includes with this paper, in an Information Disclosure Statement, copies of publications and packaging labels as well a scaled drawing of a Rodenhouse Grip-Lok® screw. The Rodenhouse Grip-Lok® screw publications have a date of June 1999. In addition, the scaled drawing, produced by the Applicant, shows various dimensional relationships of the Rodenhouse Grip-Lok® screw. Applicant notes that the Rodenhouse Grip-Lok® screw packaging is marked to reference United States Patent No. 4,959,938, which was considered by the Examiner. Applicant has cancelled allowed claims 1-5, 10, 12-22, 34-42, 44, 68-93, 99 and 101-104 in view of the Rodenhouse prior art and to eliminate duplication of claim coverage and has amended claims 6, 8 and 11 in the present application such that they are clearly patentably distinguishable from the Rodenhouse Grip-Lok® screw.

Applicant has included with the Information Disclosure Statement a 37 C.F.R. 1.97(e) statement and 37 C.F.R. 1.17(p) fee as required after Notice of Allowance, and before payment of the Issue Fee. MPEP§609.

Proposed Amendment Requires No Additional Search or Examination

The proposed amendment to the allowed claims requires no additional search or examination since the Rodenhouse Grip-Lok® screw does not teach or suggest the presently claimed device. For example, the Rodenhouse Grip-Lok® screw does not teach or suggest all of the presently claimed elements including:

the head is provided with a top surface having an opening to receive a tool and a bottom surface having a v-shaped undercut having a conical surface in the undercut that connects the lip with a conical underside of the head;

the thread pattern of the lower region is symmetrical;

a gimlet tip having an included angle from about 20° to about 30°;

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at least twice as many threads per unit length in the upper region as there are threads per unit length in the lower region;

a crown that extends around the perimeter of the head and extends beyond the lower surface of the head thereby defining an open volume between the lower edge of the crown and the shaft of the screw

a crown that extends around the perimeter of the head, wherein the crown extends beyond the lower surface of the head, forming a recessed region between the lower edge of the crown and the shaft of the screw; and/or

a bottom surface having a v-shaped undercut.

Claims Are Patentable

As discussed above, the Rodenhouse Grip-Lok® screw, which was designed and has been employed decidedly different application, does not teach or suggest all of the presently claimed elements. In addition, one of ordinary skill in the art would not have found the presently claimed device obvious in light of the prior art or knowledge within the art to which the present device is directed.

Furthermore, the Declaration under 37 C.F.R. §1.32 of Commercial Success and Unexpected Results is fully applicable to the claims remaining in the application.

Statement: Reason Not Earlier Presented

Applicant was not aware of the significance and specific structure of the Rodenhouse Grip-Lok® screw until after receiving the Notice of Allowance

Applicant hereby states that no item of information cited in the Information Disclosure Statement filed herewith was cited in a communication from a foreign patent office in a counterpart foreign application, and, to my knowledge after making reasonable inquiry, no item of information contained in the Information Disclosure Statement filed herewith was known to any individual designated in 37 C.F.R. 1.56 more than 3 months prior to the filing of the Information Disclosure Statement.


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Applicant respectfully requests that the Examiner enter the present amendments in light of the above remarks. Applicant believes that such entry, which is a matter of grace and not of right, requires no further search or examination on the part of the Examiner and are patentable for at least the reasons stated above.

Respectfully submitted,

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TAH/GDY/db
Enclosures

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